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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,555	06/04/2001	Michael Joseph Luzzio	PC10795A	7601

7590

10/27/2003

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New York, NY 10017-5755

EXAMINER
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LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/27/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/873,555

Applicant(s)

LUZZIO ET AL.

Examiner

Hong Liu

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached advisory action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-26 and 29-49.

Claim(s) withdrawn from consideration: 59-68.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### ADVISORY ACTION

The after final amendment filed on 10/13/03 cannot be entered since while narrowing the scope of previously rejected claims at R11 to limit it to a group of specific heterocycles, it would necessitate further consideration and search to determine the applicability of additional art which would render the amended claims anticipated or obvious under 35 USC 103. In addition, the definition of “prodrug” cannot be found in the original specification and thus, the specification does not provide any guidance for one skilled in the art on how to make and convert the prodrug. The compound claims containing the word “prodrug” and the method claims are still not enabled for the same reasons given in the Final Office Action.

Applicants are reminded that entry of amendment after final rejection is not a matter of right. “Except where an amendment merely cancels claims, adopts examiner suggestions, remove issues for appeal, or is some other way only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final reelection.” See MPEP 714.13. For these reasons, this amendment after final rejection will not be entered.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner’s supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for “unofficial” purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the

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status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

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October 22, 2003



**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**